

**REMARKS**

In the Office Action mailed March 24, 2010, claim 1 was objected to.

Claims 1, 3-10, and 14 were rejected under §103 for alleged obviousness by EP 1488775.

In view of the explanations presented herein, it is respectfully submitted that all claims 1, 3-10, and 14 are in condition for allowance. In addition, new claims 15 and 16 are also submitted to be in condition for allowance.

**A. Objection to Claim 1 Should be Withdrawn**

Applicant hereby confirms that the term "formed" appears in claim 1, line 8. That term exists in claim 1 as originally filed. It is respectfully requested that the present objection be withdrawn.

**B. Rejection of Claims 1, 3-10, and 14 Under §103 Should be Withdrawn**

**1. The Claims at Issue**

All pending claims recite an oil-based cleansing composition comprising, in part, (1) a nonionic surfactant having a HLB of 8 to 10, (2) an oil component having an IOB of 0.02 to 0.07, and (3) wherein the mass ratio of the nonionic surfactant to the oil component is 1:4 to 2:1. All pending claims also recite that upon mixing the oil-based cleansing composition with water in a ratio of 4:6, a micellar aqueous solution phase or a bicontinuous microemulsion phase is formed.

As explained throughout the present application, a micellar aqueous solution phase or a bicontinuous microemulsion phase exhibits particular optical properties. In

paragraph [0035], it is noted that "the micellar aqueous solution shows optically isotropic, from clear to slightly blue, translucent appearance." In paragraph [0037], it is noted that "[t]he bicontinuous microemulsion is, by appearance, a transparent, low-viscosity 1-phase, and it is optically isotropic." Furthermore, it is noted in paragraph [0009], that one of the objectives of the invention is to provide "an oil-based cleansing composition that has.... no white turbidity."

## **2. The Grounds of Rejection**

The pending claims stand rejected for alleged obviousness by EP 1,488,775. It is respectfully requested that the Examiner consider the following.

Although the '775 reference describes several components that may be used in the claimed cleansing compositions, the '775 reference entirely fails to teach, describe, or even suggest the particular combination of features (1), (2), and (3), specified in independent claim 1. It is the combination of features (1), (2), and (3), which have been surprisingly discovered to lead to the formation of aqueous mixtures that are free of white turbidity. The '775 reference entirely fails to provide any teaching, description, or even a suggestion that aqueous mixtures that are free of white turbidity are obtained by utilizing an oil-based cleansing composition having the combination of features (1), (2), and (3).

Instead, the '775 reference teaches a variety of compositions, many of which exhibit white turbidity upon mixing with water in ratios as called for in the pending claims. This fact was demonstrated in Applicant's previous filing. Applicant previously submitted the following data in Table 1 summarizing the results of various testing that

was performed. This data was submitted in a Declaration under 37 CFR §1.132 by the inventors. That Declaration accompanied previously filed Response "C."

Table 1  
Examples 5-8 (EP1488775)

	5	6	7	8
Glycerol monooleate	--	--	6	5.97
Glycerol monoisostearate	6.5	--	--	--
Safflower monoglyceride	--	4.63	--	--
Isostearyl-pentaerythryl glyceryl ether	--	4.63	--	--
POE(7) glyceryl-mono [coconut fatty acid]	--	16.54	--	--
Polyoxyethylene monolaurate	11.5	--	14.2	14.1
Decamethyl cyclopentasiloxane	21.5	--	20	19.94
Isotridecyl isononanoate	--	30.62	--	--
Liquid paraffin	54.8	45.9	54.8	42.97
Isopropyl palmitate	--	--	5	14.93
Purified water	1	0.98	3	1.09
Myristyl alcohol	4	1.33	--	--
Isostearic acid	0.7	--	--	1
Ratio of surfactant and oil (surfactant: oil)	1:4.5	1:3.68	1:3.89	1:3.93
Apparent condition (Note 1)	White turbidity	White turbidity	White turbidity	White turbidity
Phase equilibrium (Note 2)	Oil phase + Micellar aqueous solution (O/W emulsion)			

Notes to Table 1:

(1) This is the appearance of the composition when mixed with water in a ratio of 4:6.

(2) This is the phase state when the composition was mixed with water in a ratio of 4:6.

This data demonstrates that the '775 reference teaches many compositions that, upon mixing with water in a ratio of 4:6, exhibit white turbidity. The data set forth above also demonstrates that it is difficult to find the conditions at which a micellar aqueous solution phase or a bicontinuous microemulsion phase is formed when compositions are mixed with water in a ratio of 4:6. That is, the data in Table 1 demonstrates several compositions pursuant to the teachings of the '775 reference which exhibit significantly different properties than the claimed compositions and recited properties.

Thus, the following conditions which lead to formation of the claimed micellar aqueous solution phase or the bicontinuous microemulsion phase upon mixing with water, are simply not taught from the description of the '775 reference:

- 1) A HLB of a nonionic surfactant should be 8 to 10,
- 2) An oil component should have an IOB of 0.02 to 0.07, and
- 3) A mass ratio of the nonionic surfactant and the oil component should be 1:4

to 2:1.

For example, in the compositions of Examples 5-8 of EP1488775, the HLB of the nonionic surfactant is not 8 to 10 and the IOB of the oil component is not within the range of 0.02 to 0.07. Also, the mass ratio of the nonionic surfactant and the oil component is not 1:4 to 2:1. These compositions do not form a micellar aqueous solution phase or a bicontinuous microemulsion phase upon mixing with water at a ratio of 4:6, as shown in Table 1. Thus, the data of Table 1 demonstrates that if one followed the teachings of the '775 reference, one would be instructed to form compositions that are significantly different than those of the pending claims. In fact, upon further review, it will be appreciated that the '775 reference actually teaches away from the claims at issue. No doubt the Examiner will appreciate that "a prima facie case of obviousness can be rebutted if the applicant....can show that the art in any material respect taught away from the claimed invention." In re Haruna, 249 F.3d 1327, 58 USPQ2d 1517 (Fed. Cir. 2001).

Therefore, contrary to the Examiner's argument, it would not be obvious to select a composition having the features (1), (2), and (3) from the broad range of compositions taught in EP1488775. Whether EP1488775 may include a composition of the present

invention is not important, because the problem of the present invention is to specify (or provide) a safe oil-based cleansing composition that exhibits minimal eye irritation and high cleansing performance, no white turbidity, and maintains a smooth massaging characteristic even when water is interfused. The '775 reference entirely fails to describe such a composition.

Furthermore, the '775 reference does not teach compositions that form the specific phases as recited in the pending claims, i.e. a micellar aqueous solution phase or a bicontinuous microemulsion phase, and which are free of white turbidity. No explanation was provided in the rejection as to how the '775 reference teaches this aspect. Nor does the '775 reference teach the particular features of compositions which lead to the formation of the particular phases having the noted optical characteristics. In point of fact, the '775 reference provides absolutely no guidance to an artisan interested in obtaining an oil-based cleansing composition that when mixed with water in a particular ratio, exhibits an appearance that is free of white turbidity. Thus, a *prima facie* rejection under §103 has not been established. Accordingly, the present rejection is improper and must, as a matter of law, be withdrawn.

### **3. Assertions in Office Action**

Regarding various assertions by the Examiner, please consider the following.

In the most recent Office Action, the Examiner asserted "applicant's claims do not require an appearance limitation such as clarity." (Page 4, lines 12-13).

Claim 1 recites "a micellar aqueous solution phase or a bicontinuous microemulsion phase is formed when said oil-based cleansing composition and water

are mixed in the ratio of 4:6". The appearance of both of these phases is in fact, specifically described in the specification. In this regard, the specification states, "the micellar aqueous solution shows optically isotropic, from clear to slightly blue, translucent appearance" (see paragraph [0035]). Also, "the bicontinuous microemulsion is, by appearance, a transparent, low-viscosity 1-phase, and it is optically isotropic" (see paragraph [0037]). And, the objective of the present invention is to provide an oil-based cleansing composition that has high cleansing performance and no white turbidity when water is interfused (see paragraph [0009]). Therefore, it is clear that the claims at issue indirectly specify an appearance characteristic such as clarity. Accordingly, it will be understood that a composition which forms a W/O emulsion (i.e. oil phase + micellar aqueous solution) having white turbidity when water (e.g. Examples 5-8 in Table 1) is added is expressly excluded by the claims at issue. In addition, the compositions which form W/O emulsions have poor cleansing performance as shown in Table 1 or Table 5 of the specification of the present application, and this does not meet the objective of the invention (not only "no white turbidity" but also "high cleansing performance").

In the most recent Office Action, the Examiner also asserted "it is noted that applicant chose to run examples 5-8 of Table 1 of EP '775 to support his argument," (Page 5, lines 3-4).

As previously explained, the data in Table 1 shows that EP 1488775 teaches many compositions that are significantly different than the subject matter of the pending claims. These examples are presented to show the difficulty of the invention. In addition, this data demonstrates that the '775 reference actually teaches away from the

subject matter of the pending claims since many of the compositions taught in the '775 reference lead to undesirable white turbid aqueous mixtures.

Furthermore, the Examiner asserted "to establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range." (Page 5, lines 8-10). Referring to the specification of the present application, it is evident that the applicant has carried out many tests both inside and outside the claimed ranges. In the specification, Table 1 and Fig.1 show that a mass ratio of the nonionic surfactant and the oil component should be 1:4 to 2:1 and cleansing performance is poor when the composition is mixed with water and forms a W/O emulsion or liquid crystals (this is also clear from Table 5). Also, Tables 2, 3 and 4 show that an oil component should have IOB of 0.02 to 0.07 when a HLB of a nonionic surfactant is 8 to 10.

Therefore, it is respectfully submitted that additional tests are not necessary to show the criticality of the claimed ranges.

#### **C. New Claims**

New dependent claims 15 and 16 are presented for the Examiner's consideration. Each of these claims expressly recites a specific phase and appearance that forms upon mixing the oil-based cleanser composition of claim 1 with water in a ratio of 4:6.

**D. Conclusion**

In view of the foregoing, it is respectfully submitted that all claims 1, 3-10, and 14-16 are in condition for allowance.

If there are any fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. IWI-16714.

Respectfully submitted,

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